



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
Michael BLOOMBERG et al.)
Serial No.: 10/081,132) Art Unit: 2682
Filed: February 21, 2002) Examiner: Raymond B. Persino
For: COMPUTER TERMINALS)
BIOMETRICALLY ENABLED)
FOR NETWORK FUNCTIONS) Appeal No.: Not yet assigned
AND VOICE COMMUNICATION)

APPLICANT'S REPLY BRIEF

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief discusses the following issues raised in the Examiner's Answer dated May 11, 2006:

- (1) whether in claim 2 "enables voice communication to and from only each terminal for which a sensed finger-image was authenticated" should be interpreted as enabling voice communication only between terminals that have each been authenticated;
- (2) whether the following in claims 1 and 3 claims in the alternative or the conjunctive: "means...for enabling the computer terminal...to access or otherwise participate in the

performance of at least one network-related function and voice communication over the network”;

(3) whether claim 9 is in the appeal; and

(4) whether in Olshansky the service of advertising-subsidized voice communications, which includes voice communications, billing and advertising, is a single network related function.

Claim 2 provides for enabling voice communication only between terminals that have each been authenticated

The Examiner correctly interprets Applicant’s position with respect to claim 2 that the enabling means enables voice communication only between terminals that have each been authenticated.

Claim 2 expressly recites that the enabling means “enables voice communication to and from *only* each terminal for which a sensed finger-image was authenticated” (emphasis supplied). Thus, there can be no voice communication between any two terminal unless both terminals have been enabled.

It is Applicant’s position that claim 2 should be given the literal interpretation argued above, and that when so interpreted, it is allowable for the reasons argued in Applicant’s Appeal Brief.¹

Claims 1 and 3 do not claim in the alternative

Claims 1 and 3 do not claim in the alternative. For example, claim 1 recites:

means responsive to the authenticating means for enabling the computer terminal for which a sensed finger-image was authenticated to access or otherwise participate in the performance of at least one network-related function and voice communications over the network.

¹ Applicant is willing to consider amending claim 2 to address the Examiner’s comments.

In claim 1, “means...for enabling the computer terminal...to access or otherwise participate in the performance of at least one network-related function and voice communication” is not the same as “means...for enabling the computer terminal...to access or otherwise participate in the performance of at least one of a network-related function and voice communication.” Thus, the enabling means of claim 1 performs the function of enabling the computer terminal to access at least one network related function and the separate function of voice communication.

The foregoing applies to interpreting the same language in claim 3.

Page 14, lines 7-14, page 15, lines 5-19 and Fig. 8 describe an embodiment of the means in claims 1 and 3 for electronically authenticating a sensed finger-image to comprise software located locally in terminal device 100 or in the host computer system 112. Page 15, lines 12-14 and Fig. 8 describe an embodiment of the means in claims 1 and 3 responsive to the authenticating means to enable a computer terminal to participate in voice communications in the computer system to comprise the computer system 112.

Subsidized telephone calls, billing and advertising constitute a single network service in Olshanksy

Billing and advertising in Olshanksy are integral to the voice communication service and are not separate stand-alone services. The whole premise of Olshanksy is advertising- subsidized telephony. That is but one network function. The voice telephone function would not exist without the associated advertising and billing. Whether one refers to advertising and billing as being incidental to the voice communication is not determinative of whether in fact all three constitute aspects of the same network function.

Claims 1 and 3 claim “means responsive...for enabling the computer terminal...authenticated to access...at least one network-related function and voice

communications over the network.” The “at least one other network-related function” referred to in claims 1 and 3 is not part and parcel of the voice communication function, as the specification of the application clearly delineates.

The Examiner’s Answer states “Undisputed is the fact that Olshanksy teaches the performance of voice communication and services *incidental* to a telephone call, such as providing billing information or advertisements on the calling party’s display” (emphasis supplied). Applicant argues in its Brief (pages 6-9) that Olshansky enables a single function in response to authentication, which is advertising-subsidized telephony. Thus, the issue is not whether billing and advertising services in Olshanksy are incidental to voice service, but whether billing and advertising are separate stand-alone services. Applicant’s position is that they are not separate services, and that Olshanksy teaches providing a single network service – advertising-subsidized telephone calls.

Claim 9 is in the Appeal

The primary basis in the Examiner’s Answer for concluding that claim 9 is not in the Appeal is that the subject matter of claim 9 is not discussed in the Summary of Claimed Subject Matter in Applicant’s Brief. However, as acknowledged on pages 13-14 in the Examiner’s Answer, arguments are presented in Applicant’s Brief for the reversal of the rejection of claim 9 (see pages 9-10 of Applicant’s Brief).

To avoid doubt as to whether claim 9 is in the appeal or not, Applicant provides below a summary of the subject matter claimed in claim 9.

Summary of Claimed Subject Matter (Claim 9)

Claim 9 claims apparatus for voice communication over a network through a computer terminal (e.g., 100 in Fig. 8) and for biometric identification. The apparatus comprises a

telephone handset (e.g., 10 in Fig. 1), which includes a microphone (e.g., 20 in Fig. 7), a finger-image sensor (e.g., 24 in Fig. 7), circuitry coupled to the microphone and speaker which at least converts between analog and digital signals (e.g., 82 in Fig. 7), and an interface (e.g., 80 in Fig. 7) coupling the finger-image sensor and the circuitry with the computer terminal. The apparatus also includes means associated with at least one of the computer terminal and the network for electronically authenticating a finger-image sensed by the finger-image sensor based on the finger-image-related signals provided to that computer terminal (e.g., terminal 100 or host computer system 112 in Fig. 8) and means associated with at least one of the computer terminal and the network responsive to the authenticating means for enabling the computer terminal in the network to participate in voice communication over the network at least from each computer terminal for which a sensed finger-image was authenticated (e.g., host computer 112 in Fig. 8).

Page 14, lines 7-14 and page 15, lines 5-19 describe an embodiment of the means in claim 9 for electronically authenticating a sensed finger-image to comprise software located locally in terminal device 100 or in the host computer system 112. Page 15, lines 12-14 describe an embodiment of means in claim 9 responsive to the authenticating means to enable a computer terminal to participate in voice communications in the computer system to comprise the computer system 112.

None of the prior art of record discloses a system as claimed in claim 9 that comprises a telephone handset for voice communication over a network through a computer terminal where the handset includes a microphone, a finger-image sensor, circuitry coupled to the microphone and speaker which at least converts between analog and digital signals, and an interface coupling

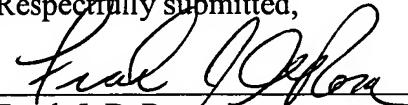
the finger-image sensor and the circuitry with the computer terminal.² Patel in Fig. 6 shows a telephone 30 with a finger print reader 28, but the telephone 30/reader 28 is not connected to a computer terminal and does not include an interface coupling a finger-image sensor and circuitry in the computer terminal.

In view of the foregoing, the Board should, and is requested to, reverse the rejections of claims 1-12.

The Commissioner is hereby authorized to charge any fee necessary to continue prosecution of this Appeal to Deposit Account No. 02-4270.

Date: June 9, 2006

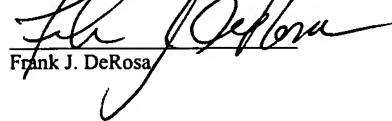
Respectfully submitted,



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Frank J. DeRosa

June 9, 2006
Date

² If the Examiner maintains his position that Claim 9 is not in the Appeal, Applicants would consider canceling claim 9 subject to the right to file a continuing application to pursue patenting the subject matter of claim 9.